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10/689,270	10/20/2003	David Ray Kraus	Kraus1	3733

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EXAMINER

HUTTON JR, WILLIAM D

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/689,270

Applicant(s)

KRAUS, DAVID RAY

Examiner

Doug Hutton

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 20031020.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities:

- The paragraph at the top of Page 8 includes confusing language. The fourth sentence states that there are several “events” that could trigger a logic unit. Then, the fifth sentence states **when** a “logic unit” is triggered, rather than specifying **events** (i.e., actions or occurrences detected by a software program) that trigger the logic unit.

Appropriate correction is required.

Claim Objections

Claim 1 is objected to because of the following informalities:

- The term “*providing*” in Lines 2-4 (4 occurrences) should be deleted because the claim is for a “*system*” (see Line 1) not a “method.” Additionally, each element of the “*system*” should be separated into its own paragraph.

Claim 4 is objected to because of the following informalities:

- The term "*said*" should be inserted between the terms "*wherein*" and "*actions*" in Line 1 because the "*actions*" were previously recited in the claims (see Claim 3, Line 5).
- The term "*said*" should be inserted between the terms "*have*" and "*execution*" in Line 1 because the "*execution means*" was previously recited in the claims (see Claim 3, Line 3).

Claim 5 is objected to because of the following informalities:

- The term "*said*" should be inserted between the terms "*wherein*" and "*actions*" in Line 1 because the "*actions*" were previously recited in the claims (see Claim 3, Line 5).
- The term "*dramatically*" in Line 3 should be deleted because such language does not conform to United States Patent practice.

Claim 6 is objected to because of the following informalities:

- The term "*wherein*" in Line 1 should be amended to — further comprising — because the claim subsequently recites another element of the "*system*."
- The term "*have*" in Line 1 should be amended to — having — so that the limitation is grammatically correct.

Claim 8 is objected to because of the following informalities:

- The phrase "*wherein providing*" in Line 1 should be amended to — further comprising — because the claim subsequently recites another element of the "*system.*"
- The term "*said*" should be inserted between the terms "*tract*" and "*users*" in Line 1 because the "*users*" were previously recited in the claims (see Claim 1, Line 7).
- The term "*said*" should be inserted between the terms "*users*" in Line 1 and "*user*" in Line 2 because the "*user defined logic units*" were previously recited in the claims (see Claim 1, Line 4).
- The term "a" should be inserted between the terms "*and*" and "*user's*" in Line 2 so that the limitation is grammatically correct.
- The semicolon at the end of the claim must be amended to a period because all claims must end with a period.

Claim 9 is objected to because of the following informalities:

- The phrase "*wherein providing*" in Line 1 should be amended to — further comprising — because the claim subsequently recites another element of the "*system.*"

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-9:

The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that would not result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

In summary, Claim 1 recites a “*system*” for tailoring a computerized questionnaire. The “*system*” is comprised solely of computer software. Thus, the recited invention is computer software *per se*.

A computer program is merely a set of instructions capable of being executed by a computer. The computer program itself is not a statutory process in that it does not include the computer-readable medium needed to realize the functionality of the computer program.

Additionally, as currently recited, Claim 1 is directed to an abstract idea that does not produce a concrete, useful and tangible result in that the questionnaire is not stored, displayed or printed.

Claims 2-9 merely additional computer software components and/or functions of the software. Thus, none of Claims 2-9 recite statutory subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-9:

Claim 1 recites "*whereby, the presentation and **answers to questions may be altered based on said logic unit execution***" in Lines 6-9.

This limitation is indefinite because it is unclear how the "*answers to questions*" are altered based on execution of the program logic. The examiner understands that, based on answers to previous questions given by the user, the sequence of questions may be altered through execution of the program logic. However, the examiner does not understand how the claimed "*answers to questions*" are **altered based on execution of the program logic** since the answers to questions are inputted by the user, not the program logic. Thus, the scope of the limitation cannot be determined by the examiner.

Claim 1 recites "*whereby, said questionnaires can be **easily and quickly** customized in real time so that each said user can request the same questionnaire, but be administered **similar, but substantially different** set of questions*" in Lines 6-9.

This limitation is indefinite because whether a questionnaire is "*easily*" and "*quickly*" customized is a completely subjective determination. Thus, the scope of the limitation cannot be determined by the examiner.

This limitation is indefinite because whether a questionnaire is "*similar*" but "*substantially different*" is a completely subjective determination. Thus, the scope of the limitation cannot be determined by the examiner. Additionally, the examiner does not understand how a questionnaire can be described as both "*similar*" and "*substantially different*."

Claim 1 recites "*whereby, said questionnaires can be easily and quickly customized in real time so that each said user can request the same questionnaire, but be administered similar, but substantially different set of questions **even if their answers to all overlapping questions are the same***" in Lines 6-9.

This limitation is indefinite because the examiner cannot determine the scope of an "*overlapping question*." This term is not defined in the Specification. Thus, it is unclear what comprises an "*overlapping question*" and what does not.

Additionally, this limitation is indefinite because it is unclear how two users can provide the same answer to the same question in the same questionnaire and yet, immediately thereafter, be provided a different question. In the context of the present

application, the examiner does not understand how this is possible, because the two users are submitting the same answer to the same question in the same questionnaire program, which should mean that the program's algorithm will follow the same path in both instances.

Claims 2-9 are dependent upon Claim 1 and thus are rejected along the same rationale.

Claim 3 recites "*a testing means to analyze zero or more environmental variables, programmatic states, stored data elements, or **other data***" in Lines 1-3.

This limitation is indefinite because it is unclear what the "*other data*" comprises. Thus, the scope of the limitation cannot be determined.

Claim 5 recites "*whereby the functionality of any logic unit (**both predetermined and customized**) can be reversed*" in Lines 2-3.

This limitation is indefinite because it is unclear whether the text within the parenthesis is intended to limit the claim. Thus, the scope of the limitation cannot be determined.

Applicant must amend the claims to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Gilman et al., U.S. Patent No. 6,725,447.

Claim 1:

Gilman discloses *a customized data collection system for individually tailoring computerized questionnaire administration* (see Figures 1-26; see Column 1, Line 1 through Column 8, Line 22 → Gilman discloses this limitation in that the system comprises methods for developing and using medical logical modules for encoding medical protocols), *comprising:*

- *providing a data collection interface* (see Figures 1-26; see Column 1, Line 1 through Column 8, Line 22 → Gilman discloses this limitation, as clearly indicated in the cited figures and text);
- *providing a rules means to store and execute zero or more predetermined logic units* (see Figures 1-26; see Column 1, Line 1 through Column 8, Line 22 → Gilman discloses this limitation in that the system comprises a memory); *and*

- *providing a customized means to store and execute zero or more user defined logic units* (see Figures 1-26; see Column 1, Line 1 through Column 8, Line 22 → Gilman discloses this limitation in that the system comprises a memory); and
- *providing a loading means to load the logic units in a prescribed order* (see Figures 1-26; see Column 1, Line 1 through Column 8, Line 22 → Gilman discloses this limitation in that the system comprises a GUI that allows a user to create an algorithm),

whereby, the presentation and answers to questions may be altered based on said logic unit execution (see Figures 1-26; see Column 1, Line 1 through Column 8, Line 22 → Gilman discloses this limitation in that the system includes flowcharts that determine paths based on data input by the user), *and whereby, said questionnaires can be easily and quickly customized in real time so that each said user can request the same questionnaire, but be administered similar, but substantially different sets of questions even if their answers to all overlapping questions are the same* (see Figures 1-26; see Column 1, Line 1 through Column 8, Line 22 → Gilman discloses this limitation in that the system allows the user to edit existing medical logical modules using the GUI).

Claim 2:

Gilman discloses *the system of Claim 1, wherein the customized data collection system includes an interface to add, modify, and delete logic units* (see Figures 1-26; see Column 1, Line 1 through Column 8, Line 22 → Gilman discloses this limitation in that the system allows the user to edit existing medical protocols using the GUI).

Claim 3:

Gilman discloses *the system of Claim 1, wherein logic unit components include:*

- *a testing means to analyze zero or more environmental variables, programmatic states, stored data elements, or other data available to the customized data collection system (see Figures 1-26; see Column 1, Line 1 through Column 8, Line 22 → Gilman discloses this limitation in that the system includes triggers that execute other logical modules and/or applications. Thus, the system includes a software module to determine when the trigger is executed.);*
- *an execution means to trigger execution of the testing means before or after zero or more programmatic events (see Figures 1-26; see Column 1, Line 1 through Column 8, Line 22 → Gilman discloses this limitation in that the system includes triggers that execute other logical modules and/or applications); and*
- *a set of zero or more actions that will run in a prescribed order for each of the testing means results (see Figures 1-26; see Column 1, Line 1 through Column 8, Line 22 → Gilman discloses this limitation in that the system includes triggers that execute other logical modules and/or applications. Thus, the system includes a software module to determine when the trigger is executed.).*

Claim 4:

Gilman discloses *the system of Claim 3, wherein actions have execution means to control any programmatic action of the customized data collection system, including sequencing, wording, response options, answers to the questionnaires, and branching*

to other said questionnaires (see Figures 1-26; see Column 1, Line 1 through Column 8, Line 22 → Gilman discloses this limitation in that the system allows the user to design all controls for every action performed during execution of the medical protocol).

Claim 5:

Gilman discloses *the system of Claim 3, wherein actions have altering means to modify the components of other said logic units, whereby the functionality of any logic unit (both predetermined and customized) can be reversed or dramatically altered for a subset of users* (see Figures 1-26; see Column 1, Line 1 through Column 8, Line 22 → Gilman discloses this limitation in that the system includes triggers that execute other logical modules and/or applications. Thus, depending on whether a particular trigger of the medical protocol is executed, the functionality of other logical modules is “*reversed or dramatically altered for a subset of users.*”).

Claim 6:

Gilman discloses *the system of Claim 5, wherein components of a logic unit have blocking means to lock one or more of said logic unit components from modification by other logic units* (see Figures 1-26; see Column 1, Line 1 through Column 8, Line 22 → Gilman discloses this limitation in that the system allows the user to design all controls for every action performed during execution of the medical protocol).

Claim 7:

Gilman discloses *the system of Claim 6, wherein blocking means have further conditional means to lock only a subset of other logic units from modifying a logic unit's components* (see Figures 1-26; see Column 1, Line 1 through Column 8, Line 22 → Gilman discloses this limitation in that the system allows the user to design all controls for every action performed during execution of the medical protocol).

Allowable Subject Matter

Claims 8 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Also, all objections and rejections that apply to Claims 8 and 9 must be obviated before the claims are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

Claim 8:

The prior art fails to disclose or suggest a system for individually tailoring computerized questionnaires comprises the combination of limitations recited in Claim 8.

Claim 9:

This claim is dependent on Claim 8 and thus includes allowable subject matter.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Fagg III, et al., U.S. Patent No. 5,960,419; Gustman et al., U.S. Patent No. 6,581,071; Callender, U.S. Patent Application Publication No. US 2002/0119433; Byers, U.S. Patent Application Publication No. US 2004/0243586; Fitzpatrick et al., U.S. Patent Application Publication No. US 2003/0097280; Bentwich, U.S. Patent No. 6,289,513; Alexander et al., U.S. Patent Application Publication No. US 2002/0069207; Huyn et al., U.S. Patent Application Publication No. US 2002/0035486; Smit et al., U.S. Patent Application Publication No. US 2004/0172520; Masarie et al., U.S. Patent Application Publication No. US 2003/0115083.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is 571-272-4137. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.


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Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

WDH

September 29, 2006



Doug Hutton
Primary Examiner
Technology Center 2100